

Statement of Considerations

REQUEST BY THERMO BLACK CLAWSON INC. (TBC) FOR AN ADVANCE WAIVER OF DOMESTIC AND FOREIGN PATENT RIGHTS TO INVENTIONS MADE UNDER A COOPERATIVE AGREEMENT ENTITLED "NEW REVOLUTIONARY SCREENING DEVICE FOR RECYCLE SYSTEM APPLICATIONS" DOE COOPERATIVE AGREEMENT DE-FC36-98GO10367; W(A)-98-020, CH0990.

Thermo Black Clawson Inc. (TBC) has requested an advance waiver of domestic and foreign patent rights to inventions its employees may conceive or first actually reduce to practice in the performance of DOE Cooperative Agreement No. DE-FC36-98GO10367.

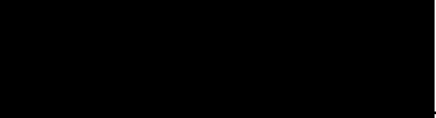
As brought out in the attached waiver petition, the work is for the design and development of a new screening device to be used by the pulp and paper industry to remove contaminants from recycled wastepaper during the paper making process. The total cost of this work under the contract is approximately \$874,661 of which TBC is committed to cost share \$437,855, or about fifty percent (50%) of the cost of the work under the agreement.


Referring to paragraph 5, 6 and 7 of TBC's waiver petition, TBC and its predecessor companies have been providing machinery and systems for the pulp and paper industry for over 100 years. Typically, TBC spends about \$2 million per year on the development of its pulp processing and recycling systems and machinery. This, coupled with TBC's established market share of the pulp screening market, clearly demonstrates its commitment to the long term development and commercialization of the technology forming the subject matter of the agreement.

TBC has agreed to the terms of the usual advance patent waiver and background data licensing provisions. These advance patent waiver provisions include a Government license, march-in rights and preference for U.S. industry provisions comparable to those set out in 35 U.S.C. 202-204, as well as the attached U.S. Competitiveness Clause, which requires that products embodying a waived invention or produced through the use of a waived invention be manufactured substantially in the United States unless the participant can show to the satisfaction of DOE that it is not commercially feasible to do so. In the event DOE agrees to foreign manufacture, there will be a requirement that the Government's support of the technology be recognized in some appropriate manner, e.g., recoupment of the Government's investment, etc. TBC has also agreed to make the above conditions binding on any assignee or licensee or any entity otherwise acquiring rights^{to} any waived invention, including subsequent assignees or licensees. Additionally, should TBC or other entity receiving rights in any waived invention undergo a change in ownership amounting to a controlling interest, the waiver, assignment, license or other transfer of rights in the waived invention is suspended until approved in writing by DOE.

The grant of this waiver is not anticipated to result in any adverse effects on competition or the public health, safety and welfare. Rather, the work should broaden the commercial alternatives available to the wastepaper recycling segment of the pulp and paper industry while enhancing its energy efficiency.

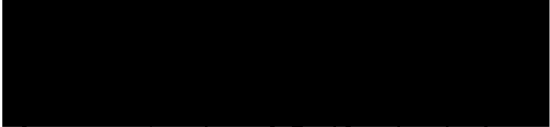
Considering the foregoing, and in view of the statutory objectives to be obtained and the factors to be considered, it has been determined that this advance waiver of patent rights will best serve the interest of the United States and the general public. Subject to TBC maintaining at least fifty percent (50%) cost sharing in aggregate, over the term of the agreement, it is recommended that the waiver be granted.


Thomas G. Anderson
Assistant Chief Counsel
Office of Intellectual Property Law
Date: 5/11/99



Joy Alwan
Patent Attorney
Office of Intellectual Property Law
Date: 11 May 99

Based upon the foregoing Statement of Considerations, it is determined that the interests of the United States and the general public will best be served by a waiver of United States and foreign rights set forth herein, and therefore the waiver is granted. This waiver shall not affect any waiver previously granted.

CONCURRENCE:


Douglas Kaempfe
Director
Office of Industrial Process Systems
EE-23
Date: 11/16/99

APPROVAL:


Paul A. Gottlieb
Assistant General Counsel
for Technology Transfer and
Intellectual Property
Date: 11-19-99

WAIVER ACTION - ABSTRACT

REQUESTOR: Thermo Black Clawson, Inc.
DE-FC36-98GO10367

CONTRACT SCOPE OF WORK: Design and development of a screening device to be used by the pulp and paper industry to remove contaminants from recycled wastepaper during the paper making process.

RATIONAL FOR DECISION: Granting of the waiver will broaden the commercial alternatives available to the wastepaper recycling segment of the pulp and paper industry while enhancing its energy efficiency.

DISPOSITION:

U.S. COMPETITIVENESS

The Contractor agrees that any products embodying any waived invention or produced through the use of any waived invention will be manufactured substantially in the United States, unless the Contractor can show to the satisfaction of DOE that it is not commercially feasible to do so. The Contractor further agrees to make the above condition binding on any assignee or licensee or any entity otherwise acquiring rights to any waived invention, including subsequent assignees or licensees. Should the Contractor or other such entity receiving rights in any waived invention undergo a change in ownership amounting to a controlling interest, then the waiver, assignment, license or other transfer of rights in the waived invention is suspended until approved in writing by DOE. In the event DOE agrees to foreign manufacture, there will be a requirement that the Government's support of the technology be recognized in some appropriate manner, e.g., recoupment of the Government's investment, etc.